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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,248	08/17/2000	Peter H. Wolf	WOLF-38176	6241

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,248

Applicant(s)

WOLF, PETER H.

Examiner

Sabrina Chang

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 51-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 51-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Declaration***

The supplemental declaration of prior invention in the United States is sufficient to overcome the cited publication filed on December 18, 2003 under 37 CFR 1.131 (MarathonFoto, dated October 1999). Specifically, the declaration admits to and provides evidence of the existence of the applicant's invention as early as May 8, 1999 (Declaration: Page 3, Para. 7. See also Exhibit C).

The examiner notes that in the applicant's declaration (Pages 6-15) there is a large amount of commentary regarding the patentability of the claims as well as general comments in response to the examiner's arguments stated in the Final Rejection (Paper #7 9/24/03). Applicant is reminded that a 1.131 declaration serves the sole purpose of antedating a reference. As such, these extraneous arguments do not move to serve this particular purpose.

Response to Arguments

Applicant's arguments filed 11/24/03 have been fully considered but they are not persuasive.

Applicant asserts that the application of Sigel et al. and Hermanns et al. as relevant art was not proper. The examiner respectfully disagrees. Applicant focuses on the concept that the technologies used are not applicable to his invention. "Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102." MPEP 2131.05. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor it is one which because of the matter with

Art Unit: 3625

which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Simply because the technology used in Sigel in Hermanns is not specifically designed for the purpose of facilitating the commercial distribution of souvenir photographs, does not preclude its application in such a context. Both Sigel and Hermanns simply provide a means for automating the process of taking a photograph in the context of a sporting event. The step of automation is used to ease the burden of the race administrator and allow for a more organized process of storing the photographs. Therefore it would have been obvious to implement such means in any sporting even context involving photography.

Applicant also asserts that the application of Gluck as relevant art is not proper. The applicant focuses on the argument that Gluck is a means of photographing event spectators instead of event *participants*. Examiner respectfully asserts that the main teaching of Gluck is not focused on the nature of person photographed but rather *how* such photographs are organized for easier searching and retrieval by a potential customer. The photographs are indexed by any number of attributes, including time, location or even a number known to the photographer and the subject of the picture [Col 7, Line 34]. As such, the examiner respectfully asserts that Gluck is properly applied where it teaches another means of indexing and searching photographs taken at an event comprising numerous people.

Generally, applicant's arguments with respect to claim have been considered but are unpersuasive and moot in view of the new ground(s) of rejection. A revised statement of rejection follows.

Art Unit: 3625

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 16-20, 59 -63 are rejected under 35 U.S.C. 103(a) as being unpatentable over MarathonFoto as described in applicant's supplemental declaration – which on Pg. 2 Para.2 states that Marathonfoto existed as early as March 14, 1998 – (hereinafter “Declaration”) in view of the article “Picture Perfect Photonet Puts Snapshots in Digital Form for Online Use” (Greim, Lisa. Rocky Mountain news. August 3, 1998).

Declaration admits that traditional methods of providing photographs to sporting event participants are well known of the art. These traditional methods consisted of the photographer contracting with the event organizer to take pictures at the event. Event participants wearing bib numbers had their pictures taken during the event (identifying data). The photographers then develop their film, visually scan the negatives for bib numbers and make thumbnail prints. Using a list of participants, including their bib numbers, names and addresses, the photographer cross-references the individual in each picture, their number and their respective address. The photographer prepares an order form with a thumbnail image attached and mails it to the corresponding participant. The customer views the thumbnail image and orders by mail, telephone or in some instances filling out an order form on-line. The photographer then fills the customer's order.

Art Unit: 3625

The “traditional” method does not disclose or account for the loading of thumbnails, or proofs, on the Internet, thereby allowing participants, or potential customers, to view pictures of themselves remotely.

Greim discusses the prevalence of online photography processing and sales. Greim also teaches that wedding photographers (event photographers) use the Internet as a “way to bypass the time-consuming shuttling of proof sets.” (inherently comprising transferring photographs to a computer network server, displaying the particular photograph for inspection and ordering) Companies offer wedding participants the ability to view and order pictures from their event online. Greim inherently comprises the storage of photographs in association with some identifying data – else there would be no means for the participants from different events to find the photographs that are relevant to them. Greim essentially teaches the benefits of viewing proofs of event photographs via the Internet as a means of cutting down on the costs and effort associated with distributing such images to event participants.

It therefore would have been obvious to modify the traditional method of sporting *event* photography to allow event participants and potential customers to view the proofs of photographs, searching by unique identifying data – i.e. the bib numbers – as disclosed in applicant’s Declaration, via the Internet, as taught by Greim, in order to decrease both the cost of proof production for the photographer as well as the waiting time for event participants to view their proofs.

Claims 5-9, 17, 64-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over MarathonFoto as described in applicant’s supplemental declaration, page 2, (hereinafter “Declaration”) in view of the article “Picture Perfect Photonet Puts Snapshots in Digital Form for

Art Unit: 3625

Online Use” (Greim, Lisa. Rocky Mountain news. August 3, 1998) in further view of Sigel et al. U.S. Patent No. 6,545,705.

The combination of Declaration/Greim does not explicitly provide for:

- o Identifying data comprises a code acquired from a component worn by an event participant
- o Triggering a camera when the component - which could comprise a passive component, a barcode - passes a predetermined point, where the point includes a sensor which interfaces with the component

Sigel et al. teaches a system for automatically taking photographs at competitive racing events. The system comprises a digital camera directed at a certain point in a race [Figure 1, Abstract]. For example the camera is set up at a human track event. The camera records an event in real time at a certain point in the race. When the image changes substantially, i.e. a person passes in front of the camera’s field of view, a static image of that instance is captured and stored externally (immediate download to server) or in the alternative that particular moment is “flagged” and indexed [Col 3, Lines 25-47].

Relevant image analysis is triggered by the initial appearance of a hand, arm or leg in the field of view of the camera (triggering the camera) [Col 11, Line 27]. The invention also contemplates that each contestant wears a special identification marker. The marker can be a barcode (passive component) [Col 12, Line 33] or lines or blocks of different colors forming a distinctive combination. In other embodiments an optical character recognition module simply could read the number on the contestant’s jersey [Col 12, Line 51]. These markers are used to analyze the captured scene and associate a particular time and image with the identity of the contestant [Col 4, Line 18].

Art Unit: 3625

Sigel et al. does not explicitly disclose that the pictures are stored for retrieval by the race participants for potential reprint purchase. However, the system of Sigel et al. seeks to solve the same problem of Declaration/Greim, in providing a more efficient and accurate method of cataloging photographs taken at an event where there are many participants. Further the system of Sigel et al. seeks to minimize the efforts of the photographers by automating the picture taking. It would have been obvious to the skilled artisan to modify the photo previewing and ordering system of Declaration/Greim to include the database storing and searching capabilities, i.e. searching by a component worn by the participant, as taught by Sigel et al., in order to automate and increase the efficiency of providing race results and images.

Claims 10 –12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MarathonFoto as described in applicant's supplemental declaration, page 2, (hereinafter "Declaration") in view of the article "Picture Perfect Photonet Puts Snapshots in Digital Form for Online Use" (Greim, Lisa. Rocky Mountain news. August 3, 1998) in further view of Sigel et al. U.S. Patent No. 6,545,705 and further in view of Hermanns et al. U.S. Patent No. 4,274,076.

The combination of Declaration/Greim/Sigel does not explicitly provide that the component worn by the participant, that triggers the camera, is an inductive circuit or an active component that includes an electronic device having a transmitter.

Hermanns et al. teaches a system for determining the moment when competitors in a race pass the finish line. Race participants wear active transmitters that trigger sensors located at the finish line. Each contestant is associated with a unique transmitter [Col 1, Line 47] and their finishing time can be accurately linked to their unique ID.

Art Unit: 3625

In that the method used to trigger the camera in the system of Declaration/Greim/Sigel could have been one of any number of methods, active, using a transmitter, or passive, when the field of view changes, it would have been obvious to one skilled in the art at the time to provide for the triggering of a instance, for example the triggering of a camera, by the crossing of an active transmitter over a sensor, as taught by Hermanns et al., in order to provide the administrator with more flexible methods of automating the camera system.

Claim 13-15, 51-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over MarathonFoto as described in applicant's supplemental declaration, page 2, (hereinafter "Declaration") in view of the article "Picture Perfect Photonet Puts Snapshots in Digital Form for Online Use" (Greim, Lisa. Rocky Mountain news. August 3, 1998), as applied in claim 1, and further in view of Gluck U.S. Patent No. 6,532,345.

The system of Declaration/Greims does not explicitly provide that:

- The identifying data comprises the date and time the photograph was taken
- An approximate time can be used to search for a particular photograph

Gluck discloses a method for producing and distributing personalized photographic souvenirs to people at an event. In one embodiment, pictures are taken of individuals, without their prior knowledge, and stored at a central server [Fig.4, Elements 400c and 406]. For example, photos can be taken while participants are in line at the event and souvenirs can then be indexed by the time and location. Participants can then search for and retrieve photos of themselves using these factors, i.e. time or location, at a later time. [Col 7, Line 28].

In that the combination of Declaration/Greims provides photograph proofs that are searchable by identifying data, i.e. bib number, it would have been obvious to one skilled in the

Art Unit: 3625

art at the time to further modify the system to allow for the an indexing system that allows user to search for their picture using any means, such as the approximate time at which they were at a certain place, as taught by Gluck, in order to offer the participant as many opportunities as possible to find and purchase a photo of themselves at the event [Cols 1-2].

The system of Declaration/Greims/Gluck does not explicitly provide that the approximate time to used to search for the photograph is a function of the total distance/time ran by the event participant and the distance of the photographer from the starting point. However, it would have been obvious to one skilled in the art at the time, to use any readily available method to approximate the time at which a participant reached a certain location. Such an approximation could be calculated using any number of combinations of the total race time, the photographer's distance, or any attribute the administrator chooses. The specific equation applied does not result in an improvement to the system or have an unpredictable result.

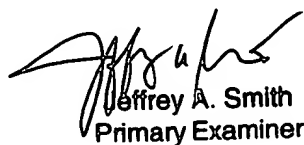
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588 the fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith
Primary Examiner